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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/903,831 | 07/11/2001 | Thomas J. Maginot | 22220-06167 | 1578 |
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| FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041 | | | EXAMINER PREBILIC, PAUL B | |
| | | | ART UNIT 3738 | PAPER NUMBER |

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,831

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebilio

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-73, 75-78, 80-109, 114, 117-119, and 121-166 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 108, 114 and 140 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 72, 83, 87, 89, 97, 103, 141, 147, 149, 154, 158 and 163-165 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims rejected are 70,71,73,75-78,80-82,84-86,88,90-96,98-102,104-107,109,117-119,121-139,142-144,146,148,150-153,155-157,159-162 and 166.

The indicated allowability of claims 70, 71, 73, 75-78, 80-82, 84-86, 88, 90-96, 98-102, 104-107, 109, 117-119, 121-130, 132-139, 142-144, 146, 148, 150-153, 155-157, 159-162, and 166 is withdrawn in view of newly discovered prior art.

Claim Objections

Claims 131 and 150 are objected to because of the following informalities:

Regarding claim 131, "the blood vessel" lacks antecedent basis.

Regarding claim 150, line 4, "the four struts" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70, 71, 73, 75-78, 80-82, 84-86, 88, 90-96, 98-102, 104-107, 109, 117-119, 121-130, 132-139, 142-144, 146, 148, 150-153, 155-157, 159-162, and 166 rejected under 35 U.S.C. 102(e) as being anticipated by Piplani et al (US 5,489,295). Piplani anticipates the claim language where the locating step is not specifically disclosed thereby but inherent thereto because the graft is shown within the delivery device in Figures 9 to 19. The arms as claimed are met by the legs or struts of a Piplani

as attachment means (126), the alignment step as claimed is performed in Figures 9 and 10 of Piplani where the graft is inserted into the hole (226). The attachment means self-expands so the claimed spring action and resiliency is met; see column 9, lines 7-12.

Regarding claim 70 and the other claims that set forth a flange portion, the claimed flange portion is made up coil spring (203) and/or hook-like elements (207) which constitute a projecting rim, edge, or collar to provide a place to attach other objects; i.e. a flange.

Regarding claim 84, the blood vessel as claimed is the femoral artery of Piplani.

Regarding claim 117, the claimed arrangement occurs as the Piplani device is inserted through hole (227); see supra.

Regarding claim 142, the order of the steps recited in the claim is not fixed such that the aligning step can be done before the advancing step.

Regarding claims 109 and 153, some additional advancing of the graft is not precluded by the present claim language such that the claimed method is reads on what is disclosed by Piplani.

Claims 77 and 150 are rejected under 35 U.S.C. 102(b) as being anticipated by Ersek (US 3,657,744). Ersek meets the claim language where the arms or struts as claimed are the metal members (22) of the sleeve (16) of Ersek; see Figure 1 and columns 2 and 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 75, 78, 121-126, 128, 131, 132, 134-136, 142, and 151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ersek (US 3,657,744) in view of Barone et al (US 5,360,443). Ersek meets the claim language where the arms (claims 75 and 78) as claimed are the metal members (22) of Ersek and the strut assembly as claimed (claim 121) is sleeve (16) of Ersek; see Figure 1 and columns 2 and 3. Ersek fails to disclose the use of a delivery device over the graft as claimed. However, Barone teaches that it was known to insert similar devices into arteries with a delivery device that encompasses the implant; see Figures 1 and 9. Therefore, it is the Examiner's position that it would have been considered prima facie obvious to insert the sleeve into the aorta of Ersek's invention so that less abrasion would occur to the inside of the aorta by the outside catheter or capsule as compared to the sleeve.

Allowable Subject Matter

Claims 72, 83, 87, 89, 97, 103, 141, 147, 149, 154, 158, 163, 164, and 165 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 108, 114, and 140 are allowable over the prior art of record.

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Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
Art Unit 3738